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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/971,903 11/17/97 HARUKI

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TM02/0510

EXAMINER

MYHRE, J

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

05/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/971,903

Applicant(s)
Haruki et al

Examiner
James Myhre

Art Unit
2162



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 27, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on April 27, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/971,903 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2. The preliminary amendment filed on April 27, 2001 has been considered but is ineffective to overcome the Hill (5,761,649) and Peschel, Joe, (Infoworld) references. The Examiner acknowledges the cancellation of Claim 9 by the Applicant. Claims 1-8 and 10-20 remain active.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (5,761,649) in view of Peschel, Joe, InfoWorld and Bisson, Giselle, M2Presswire.

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Claims 1, 10-13, 16, and 17: Hill discloses a system and method for registering and updating software on a remote computer, comprising:

a. User information general management means managing user registration information and status information by managing product information data and providing new or updated information in accordance with a request from a user (col 4, lines 22-40 and col 5, lines 57-67); and

b. User registration/reference means for notifying the general management means of the user registration and status information and for requesting new information about the product (col 4, lines 9-21 and col 5, lines 51-57).

Hill further discloses the user registration information containing an identification number of each user (col 13, lines 40-43) and product information, such as version update (revision level)(col 13, lines 46-51). Hill also discloses extracting information (support files) about the products and transmitting the information to the user (col 14, lines 40-56) upon user request. Thus, Hill discloses the user requesting either an update or support files (Applicant's "requested information type").

The Examiner considers the support files disclosed by Hill as the equivalent of the claimed "products which can be used in combination with products that are used by the users".

Furthermore, Peschel discusses a software application called *Oil Change* from CyberMedia Inc. which automatically updates applications and drivers on a user's computer by connecting to a centralized external database. Again, the Examiner considers the drivers as products used in

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combination with products on the user's system. Peschel further discusses that it includes "updates for other programs and drivers" and that it "has formed partnerships with several companies so that they can directly update Oil Change's database" (page 2, lines 6-7). This feature of *Oil Change* is further discussed by Bisson, Giselle of CyberMedia in a January 9, 1997 article which states that "If *Oil Change* notices a missing or outdated driver, it notifies the user, and with permission, downloads and installs it automatically. The customized version of *Oil Change* will update the drivers for all of the peripherals and components in the Sony PC, as well as Sony-specific software" (page 14). Thus, *Oil Change* not only identifies missing or outdated products (drivers) associated with products used on the user's system, but also notifies the user of this information and lets the user decide whether or not to allow *Oil Change* to download the new product, which could come from any of the multiple vendors (companies) which update the Oil Change database.

However, while Hill discloses providing software updates or support files to a user either automatically or upon receipt of a request from the user, Hill does not explicitly disclose storing the requesting information type as part of the registration information. Official Notice is taken that it is old and well known within the computer arts to maintain user preference data and to use this user preference data to filter information transmitted to the user. The stored user preferences are commonly used by marketers to present targeted advertisements, by autonomous browsers (agents) to forward information about new products and services, by email service providers to eliminate unwanted or inappropriate information (such as adult material to a minor's account),

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etc. Moreover, most software vendors offer a wide variety of software types and oftentimes multiple software titles of the same software type (word processors, for example). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a parameter within the client's registration information indicating the type of information preferred by the user. One would have been motivated to include user preference information in order to give the user better control over the amount and content of information received.

Claim 2: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 1 above, and Hill further discloses means for the user to request new information about a product from the general management means (col 5, lines 4-30).

Claim 3: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Hill further discloses the registration process being built into the software and automatically executed upon installation on the user's computer (col 4, lines 11-15; col 5, lines 30-36; and col 9, lines 46-48).

Claim 4: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Hill further discloses:

- a. A personal identification number as part of the registration information (col 4, lines 15-31); and

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b. The type of requested information which is extracted by the general management means and transmitted to the user (col 3, lines 9-31).

Claims 5 and 6: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, but do not explicitly disclose basing the automatic update of the software on the number of times the application had been accessed. Official notice is taken that it is old and well known within the technological art to conduct periodic checks of software and that these checks could be based on a time limit or a maximum number of uses. An example of using the usage number in the industry is the "demo" software programs available from vendors. A demo is normally able to be used for a limited number of times, after which it either erases itself, prevents the user from activating the program, or it merely notifies the user that the "free use" period has expired. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to periodically check the software applications being tracked by Hill's invention and that these checks could be based on usage or time. One would have been motivated to track them by the number of times the software had been used in order to minimize the number of updates by ensuring the software with the highest usage level is always at the most up-to-date status possible and the software which is seldom used is only updated when it needs to be used.

Claims 7, 8, 14, 15, and 18-20: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, but Hill does not explicitly disclose multiple vendors updating the product information database of the general

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management means by providing new information pertaining to the type of product as requested by the user. Peschel further discusses allowing vendors (companies) to directly update the information about their products in the database (page 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Hill's general management means' database by connecting to one or more external vendors and to allow them to update their product's information. One would have been motivated to do this in order to increase the number of software products that Hill's system could update and to ensure that the database contained the latest information available from each vendor as discussed by Peschel.

Response to Arguments

5. Applicant's arguments filed April 27, 2001 have been fully considered but they are not persuasive.

a. Applicant argues that "the drivers disclosed in Peschel are for use only with a product sold by the same vendor that makes the driver" (page 11); however, the Examiner can find no such limitation in Peschel. It is merely disclosed that the Oil Change database contains update files for programs and drivers and that these update files can be directly added to the Oil Change database by several companies (vendors). It is very common within the software industry for multiple vendors to develop enhancements and updates to other vendors' software applications, such as the wide myriad of screensavers available from various vendors which are compatible with Microsoft Windows, Macintosh software, UNIX software, etc. Since Peschel discloses that

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multiple vendors can add their products to the Oil Change database and that the database is used to update the user's software, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the software and the products need not necessarily come from the same vendors.

b. Applicant further argues that neither Hill nor Peschel discloses "information which signifies a difference in vendor of the products" (page 13). The Examiner notes that Peschel discloses presenting a list of update files found, along with a brief description of each and the approximate download time. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the brief description of the update file would include information about the vendor of the update file, but also information about which application(s) could be updated by it. Thus, as in the Applicant's example (page 11), if Oil Change found that the user needed to update the Flash plug-in for the Netscape application program, the user would be presented with a brief description of the Flash plug-in to include where the plug-in came from (update vendor), which application it is used with (Netscape browser), and a synopsis of what the update changes in the application.

c. Applicant cited the Advisory Action dated April 12, 2001 and requested a Non-Final Office Action based on the two web sites cited as prior art (page 1). However, these are not websites, but retail stores which the Examiner merely cited to show that it is common for software vendors (retailers) to offer products from more than one vendor. The Examiner could name dozens of other software retailers which also offer products from multiple vendors. Indeed,

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it would be difficult to find a software retailer who only offers one vendor's products. Therefore, as noted below, this action is made Final.

Conclusion

6. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 2100 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-3900.


JWM
May 8, 2001


ERIC W. STAMBER
PRIMARY EXAMINER